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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,692	10/31/2003	James V. Donadio III	AZMED.0100	1913
7590	05/15/2006		EXAMINER	
Law Offices of Daniel J. Noblitt, LLC Attn: Daniel J. Noblitt 3370 North Hayden Road, Suite 123 Box 258 Scottsdale, AR 85251			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 05/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/698,692	DONADIO, JAMES V.
	<b>Examiner</b> Matthew J. Daniels	<b>Art Unit</b> 1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Statys

1)  Responsive to communication(s) filed on 21 February 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-66 is/are pending in the application.  
4a) Of the above claim(s) 16-51 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-15 and 52-66 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/31/03, 4/30/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species C in the reply filed on 21 February 2006 is acknowledged. The traversal is on the ground(s) that the species are not mutually exclusive. Applicant's arguments, which appear to argue that the species are related and not patentably distinct, are persuasive. The election/restriction requirement mailed 16 November 2005 is withdrawn. Claims 1-15 and 52-66 have been examined.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1, 5, 6, 11-14, 52, 56, 57, and 62-65** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 23, 24, 26-28, and 35 of copending Application No. 10/393,175. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Claims 1 and 52 over claim 13 of the '175 application

Both sets of claims are drawn to providing a mandrel, filling a device pattern on the surface of the mandrel, and dissolving the mandrel.

Claims 5 and 56 over claim 24 of the '175 application

Both sets of claims are drawn to a rounded trough or bottom.

Claims 6 and 57 over claim 23 of the '175 application

Both sets of claims are drawn to vapor depositing.

Claims 11-14 and 62-65 over claims 26, 27, 28, and 35 of the '175 application

Both sets of claims are drawn to a multilayered material, a radiopaque material, overfilling, and removing or having removed excess.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 15 and 66** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for fully dissolving the mandrel, does not reasonably provide enablement for changing the configuration of the stent material after the partial dissolution of the mandrel and before the full dissolution of the mandrel. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the method steps pertaining to the invention commensurate in scope with these claims. How is the configuration changed and how does this materially affect the claimed method?

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 5, 6, 11-14, 52, 56, 57, and 62-65** are rejected under 35 U.S.C. 102(e) as being anticipated by Application No. 10/393,175.

Claims 1 and 52 over claim 13 of the '175 application

Both sets of claims are drawn to providing a mandrel, filling a device pattern on the surface of the mandrel, and dissolving the mandrel.

Claims 5 and 56 over claim 24 of the '175 application

Both sets of claims are drawn to a rounded trough or bottom.

Claims 6 and 57 over claim 23 of the '175 application

Both sets of claims are drawn to vapor depositing.

Claims 11-14 and 62-65 over claims 26, 27, 28, and 35 of the '175 application

Both sets of claims are drawn to a multilayered material, a radiopaque material, overfilling, and removing or having removed excess.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. **Claims 1, 5, 11, 12, 14, 52, 56, 62, 63, and 65** are rejected under 35 U.S.C. 102(b) as being anticipated by Clubb (USPN 6203732). **As to Claim 1**, Clubb teaches a method of making a stent, comprising:

providing a mandrel having a stent pattern (4:34-43);  
filling the stent pattern with a stent material (4:34-43); and  
dissolving the mandrel (4:54-61).

**As to Claim 5**, Clubb teaches a method of making a stent wherein the stent pattern includes a rounded trough surface (Fig. 16). **As to Claims 11 and 12**, see 5:10-20. **As to Claim 14**, see 2:65-66. **As to Claim 52**, Clubb teaches a method of making a device, comprising:

providing a mandrel having a device pattern (4:34-43);  
filling the device pattern with a device material (4:34-43); and  
dissolving the mandrel (4:54-61).

**As to Claim 56**, Clubb teaches a method of making a device, wherein the device pattern includes a rounded trough surface (Fig. 16). **As to Claims 62 and 63**, see 5:10-20. **As to Claim 65**, see 2:65-66.

6. **Claims 6 and 57** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Clubb (USPN 6203732). Clubb teaches the subject matter of Claims 1 and 52 above under 35 USC 102(b). **As to Claims 6**, Clubb teaches vapor deposition (4:39-40). Although silent to “chemical” vapor deposition, the Examiner submits that this would have been the inherent or obvious choice to vapor deposit the desired layer. **As to Claim 57**, Clubb teaches vapor deposition (4:39-40). Although silent to “chemical” vapor deposition, the Examiner submits that this would have been the inherent or obvious choice to vapor deposit the desired layer.

7. **Claims 1, 6, 11-14, 52, 57, 62-65** are rejected under 35 U.S.C. 102(b) as being anticipated by Whitcher (WO 01/55473). **As to Claim 1**, Whitcher teaches a method of making a stent, comprising:

providing a mandrel having a stent pattern (Figs 11-13, item 105);  
filling the stent pattern with a stent material (Figs. 11-13, item 115); and  
dissolving the mandrel (page 12, lines 15-25).

**As to Claim 6**, see page 6, lines 15-20.

**As to Claims 11 and 12**, see page 15, line 25 to page 16, line 8.

**As to Claims 13 and 14**, see page 14, lines 4-10.

**As to Claim 52**, Whitcher teaches a method of making a device, comprising:

providing a mandrel having a device pattern (Figs 11-13, item 105);  
filling the stent pattern with a device material (Figs. 11-13, item 115); and  
dissolving the mandrel (page 12, lines 15-25).

**As to Claim 57**, see page 6, lines 15-20.

**As to Claim 62 and 63**, see page 15, line 25 to page 16, line 8.

**As to Claims 64 and 65**, see page 14, lines 4-10.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Yang (USPN 5977230). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). **As to Claims 2-4**, Whitcher appears to be silent to the mandrel mold, metal injection molding, or placing of powdered metal. However, Yang teaches these aspects (1:10-52, 3:55-65, column 4). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Yang into that of Whitcher in order to provide the ability to a) provide intricate detailed features that can be molded into a green preform, including contoured surfaces, and b) in order to provide a molded article that is the same shape every time, providing uniformity from part to part, and c) in order to minimize waste (1:30-37).

9. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Clubb (USPN 6203732). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). **As to Claim 5**, Whitcher is silent to the rounded trough. However, Clubb teaches a rounded trough (Figs. 9-18). Additionally, this appears to be an article limitation which would not materially affect the method. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Clubb into that of Whitcher in order to a) avoid stress concentrators in the stent, b) provide a rounded surface to reduce risk of damage to blood vessels, c) because Whitcher specifically suggests that

the shsapes be varied for particular applications (page 10, lines 15-16 and elsewhere), and d) because a rounded trough is a common shape for etched lines, and Whitcher teaches that etching is one suitable method for forming the trenches (page 14, line 16).

10. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lazarov (USPN 6110204). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). **As to Claim 7**, Whitcher is silent to the filling of the stent pattern with a porous stent material. However, Lazarov teaches this aspect (2:22-3:46). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Lazarov into that of Whitcher because Lazarov specifically suggests the method to be used for stents (2:20), and because doing so would provide an implant having reduced formation of thrombi and biofilm (Lazarov, 2:1-12).

11. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lazarov (USPN 6110204) and Ding (WO 00/01322). Whitcher and Lazarov teach the subject matter of Claim 7 above under 35 USC 103(a). **As to Claim 8**, Whitcher is silent to the saturating with porous stent material. However, Ding teaches filling pores with a fluid (pages 9-11). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ding into that of Whitcher and Lazarov because Ding clearly suggests this method for stents (page 3), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

12. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lye (US 2004/0148015). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). **As to Claims 9 and 10**, Whitcher appears to be silent to forming pores and filling with a fluid. However, Lye teaches forming pores and filling with a fluid (paragraphs 20 and 22). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Lye into that of Whitcher because Lye clearly suggests this method for stents (paragraph 20), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

13. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Ding (WO 00/01322). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). **As to Claims 9 and 10**, Whitcher appears to be silent to forming pores and filling with a fluid. However, Ding teaches forming pores and filling with a fluid (pages 9-11). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ding into that of Whitcher because Ding clearly suggests this method for stents (page 3), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

14. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Hines (USPN 6019784). Whitcher teaches the subject matter of Claim 1 above under 35 USC 102(b). Note also the rejection of Claim 15 under 35 USC 112 above. **As to Claim 15**, Whitcher clearly suggests depositing a mask that is shaped as the inverse of the

desired pattern (page 13, lines 19-31). Hines teaches a process of making a stent in which the mask is a photoresist mask (3:50-4:52), and it is well known in the art that conventional photoresists are organic coatings. Whitcher further teaches that after the deposition of the coating, it is desirable to perform other fabrication steps including “heat treating, oxidizing, welding, attaching to other components” (page 16, line 13) or thermomechanical training of Nitinol materials (page 16, lines 14-16). In the combined method, it would have been *prima facie* obvious to dissolve and remove the organic photoresist (partially dissolve the mandrel) prior to changing the configuration by heat treating (including thermomechanical training), oxidizing, welding, or attaching other components, because these processes would either a) decompose the photoresist and lead to potential contamination, or b) obstruct access to those parts of the stent or device that are to be welded, oxidized, or attached. Dissolving of the photoresist is interpreted to be partial dissolving and dissolving the mandrel, as taught by Whitcher in the rejection of Claim 1, is interpreted to fully dissolving the mandrel. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hines into that of Whitcher because Whitcher clearly suggests the masking method (cited above), and this is the method that Hines provides.

15. **Claims 53-55** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Yang (USPN 5977230). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). **As to Claims 53-55**, Whitcher appears to be silent to the mandrel mold, metal injection molding, or placing of powdered metal. However, Yang teaches these aspects (1:10-52, 3:55-65, column 4). It would have been *prima facie* obvious to

one of ordinary skill in the art at the time of the invention to incorporate the method of Yang into that of Whitcher in order to provide the ability to a) provide intricate detailed features that can be molded into a green preform, including contoured surfaces, and b) in order to provide a molded article that is the same shape every time, providing uniformity from part to part, and c) in order to minimize waste (1:30-37).

16. **Claim 56** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Clubb (USPN 6203732). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). **As to Claim 56**, Whitcher is silent to the rounded trough. However, Clubb teaches a rounded trough (Figs. 9-18). Additionally, this appears to be an article limitation which would not materially affect the method. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Clubb into that of Whitcher in order to a) avoid stress concentrators in the stent, b) provide a rounded surface to reduce risk of damage to blood vessels, c) because Whitcher specifically suggests that the shapes be varied for particular applications (page 10, lines 15-16 and elsewhere), and d) because a rounded trough is a common shape for etched lines, and Whitcher teaches that etching is one suitable method for forming the trenches (page 14, line 16).

17. **Claim 58** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lazarov (USPN 6110204). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). **As to Claim 58**, Whitcher is silent to the filling of the stent pattern with a porous stent material. However, Lazarov teaches this aspect (2:22-3:46). It would

have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Lazarov into that of Whitcher because Lazarov specifically suggests the method to be used for stents (2:20), and because doing so would provide an implant having reduced formation of thrombi and biofilm (Lazarov, 2:1-12).

18. **Claim 59** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lazarov (USPN 6110204) and Ding (WO 00/01322). Whitcher and Lazarov teach the subject matter of Claim 58 above under 35 USC 103(a). **As to Claim 59**, Whitcher is silent to the saturating with porous stent material. However, Ding teaches filling pores with a fluid (pages 9-11). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ding into that of Whitcher and Lazarov because Ding clearly suggests this method for stents (page 3), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

19. **Claims 60 and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Lye (US 2004/0148015). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). **As to Claims 60 and 61**, Whitcher appears to be silent to forming pores and filling with a fluid. However, Lye teaches forming pores and filling with a fluid (paragraphs 20 and 22). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Lye into that of Whitcher because Lye clearly suggests this method for stents (paragraph 20), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

20. **Claims 60 and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Ding (WO 00/01322). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). **As to Claims 60 and 61**, Whitcher appears to be silent to forming pores and filling with a fluid. However, Ding teaches forming pores and filling with a fluid (pages 9-11). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ding into that of Whitcher because Ding clearly suggests this method for stents (page 3), and because doing so would provide pharmaceutical benefit to the patient implanted with the device.

21. **Claim 66** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher (WO 01/55473) in view of Hines (USPN 6019784). Whitcher teaches the subject matter of Claim 52 above under 35 USC 102(b). Note also the rejection of Claim 66 under 35 USC 112 above. **As to Claim 66**, Whitcher clearly suggests depositing a mask that is shaped as the inverse of the desired pattern (page 13, lines 19-31). Hines teaches a process of making a stent in which the mask is a photoresist mask (3:50-4:52), and it is well known in the art that conventional photoresists are organic coatings. Whitcher further teaches that after the deposition of the coating, it is desirable to perform other fabrication steps including “heat treating, oxidizing, welding, attaching to other components” (page 16, line 13) or thermomechanical training of Nitinol materials (page 16, lines 14-16). In the combined method, it would have been *prima facie* obvious to dissolve and remove the organic photoresist (partially dissolve the mandrel) prior to changing the configuration by heat treating (including thermomechanical training),

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oxidizing, welding, or attaching other components, because these processes would either a) decompose the photoresist and lead to potential contamination, or b) obstruct access to those parts of the stent or device that are to be welded, oxidized, or attached. Dissolving of the photoresist is interpreted to be partial dissolving and dissolving the mandrel, as taught by Whitcher in the rejection of Claim 1, is interpreted to fully dissolving the mandrel. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hines into that of Whitcher because Whitcher clearly suggests the masking method (cited above), and this is the method that Hines provides.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 5/5/06



MICHAEL P. COLAIANNI  
SUPERVISORY PATENT EXAMINER